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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)
035826-027

First named inventor: Paul A. Nysen

Application No.: 09/738,819

Art Unit: 2635

Filed: December 15, 2000

Examiner: Vernal U. Brown

Title: Apparatus and Method for Locating a Tagged Item

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX: (703) 872-9306

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JUL 26 2004

OFFICE OF PETITIONS

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Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity - fee \$665 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$_____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in
the form of RCE & Amendment/Response (identify type of reply):

☐ has been filed previously on _____.

☒ is enclosed herewith.

B. The issue fee of \$ _____

☐ has been paid previously on _____.

☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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07/22/2004 AWONDAF1 00000038 09738819

01 FC:2453

665.00 OP

3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$_____ for a small entity or \$_____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

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7-15-04

Date

Signature

Telephone

Number: (408) 282-1857

William E. Winters

Typed or printed name

P. O. Box 640640

Address

San Jose, CA 95164-0640

Address

Enclosures: ☒ Fee Payment

☒ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☐ Other : _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(A)]

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☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the Patent and Trademark Office at (703) 872-9306.

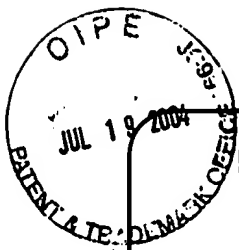
7-16-04

Date

Signature

Diane Morse

Typed or printed name of person signing certificate



FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 1050

Complete If Known

Application Number	09/738,819
Filing Date	December 15, 2000
First Named Inventor	Paul A. Nysen
Examiner Name	Vernal U. Brown
Art Unit	2635
Attorney Docket No.	035826-027

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money ☐ Other ☐ None
Order

☒ Deposit Account:

Deposit
Account
Number

50-1698

Deposit
Account
Name

Thelen Reid & Priest LLP

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee
to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1)

(\$ 0)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims	Fee from below	Fee Paid
Total Claims	-20 **	= 0	X	= 0
Independent Claims	-3 **	= 0	X	= 0
Multiple Dependent			X	= 0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$ 0)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	665
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	385
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$ 1050)

SUBMITTED BY

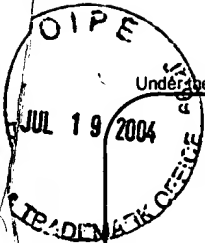
Complete (if applicable)

Name (Print/Type)	William E. Winters	Registration No. (Attorney/Agent)	42,232	Telephone	408-292-5800
Signature		Date	7-15-04		

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Request For Continued Examination (RCE) Transmittal

Address to:
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P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	09/738,819
Filing Date	December 15, 2000
First Named Inventor	Paul A. Nysen
Art Unit	2635
Examiner Name	Vernal U. Brown
Attorney Docket Number	035826-027

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This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 C.F.R. 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
ii. ☐ Other _____

- b. ☒ Enclosed

- i. ☒ Amendment/Reply
ii. ☐ Affidavit(s)/Declaration(s)
iii. ☐ Information Disclosure Statement (IDS)
iv. ☐ Other _____

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. 1.17(i) required)
b. ☐ Other _____

3. **Fees** The RCE fee under 37 C.F.R. 1.17(e) is required by 37 C.F.R. 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 50-1698
i. ☒ RCE fee required under 37 C.F.R. 1.17(e)
ii. ☐ Extension of time fee (37 C.F.R. 1.136 and 1.17)
iii. ☒ Other Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)
b. ☒ Check in the amount of \$ 1,050 enclosed
c. ☐ Payment by credit card (Form PTO-2038 enclosed)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print /Type)	William E. Winters	Registration No. (Attorney/Agent)	42,232
Signature		Date	7-15-04

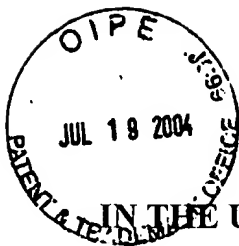
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Name (Print /Type)	Diane Morse	Date	7-16-04
Signature			

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035826-027 (formerly-XCI-232-KFM)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

#8
9/23/04
(fu)

APPLICANT: Paul Nysen
SERIAL NO.: 09/738,819
FILING DATE: December 15, 2000
TITLE: APPARATUS AND METHOD FOR LOCATING A TAGGED ITEM
EXAMINER: Brown, Vernal U.
ART UNIT: 2635

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Date: 7-16-04

Name: Diane Morse
Diane Morse

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

**REVOCATION OF POWER OF ATTORNEY AND NEW POWER OF
ATTORNEY**

The undersigned, having authority to act as the owner of the entire title to the patent application identified above, hereby revokes all powers of attorney previously given and hereby appoints Robert E. Krebs, Registration No. 25,885; David B. Ritchie, Registration No. 31,562; Marc S. Hanish, Registration No. 42,626; John P. Schaub, Registration No. 42,125; Adrienne Yeung, Registration No. 44,000; Steven J. Robbins, Registration No. 40,299; Thierry K. Lo, Registration No. 49,097; William Samuel Niece, Registration No.: 47,824; Khaled Shami, Registration No. 38,745; William E. Winters, Registration No. 42,232; Masako Ando, (37 C.F.R. §10.9 (b)); and John Klaas Uilkema, Registration No. 20,282; Becky L. Troutman,

035826-027 (formerly-XCI-232-KFM)

Registration No. 36,703; Hal J. Bohner, Registration No. 27,856, to act on applicant's behalf
before the United States Patent and Trademark Office for the above-identified application and to
transact all business in the Patent and Trademark Office in connection therewith.

Please mail all correspondence to Robert E. Krebs at the following address:

THELEN REID & PRIEST LLP
P.O. BOX 640640
SAN JOSE, CA 95164-0640

and direct all telephone calls to Robert E. Krebs at (408) 292-5800.

Dated: 03/04/04


Name: Keith L. Cocina
Title: President

SV #159243 v1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9

APPLICANT: Paul A. Nysen
APPLICATION NO.: 09/738,819
FILING DATE: December 15, 2000
TITLE: APPARATUS AND METHOD FOR LOCATING A
TAGGED ITEM
EXAMINER: Vernal U. Brown
ART UNIT: 2635

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Date: 7-16-04

Name: Diane Morse
Diane Morse

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22-313-1450

AMENDMENT

In response to the Office Action dated November 17, 2003, please amend the
above-identified application as follows.

Amendments to the Claims are reflected in the listing of claims, which begins
on page 2 of this paper.

Remarks/Arguments begin on page 6 of this paper.

Amendments to the Claims:

The listing of claims below will replace all prior versions and listings of claims in the application:

Listing of Claims:

1. (Previously Presented) Apparatus for determining the location of an item, from among a plurality of like items, said apparatus comprising, in combination:
 - (a) a paging device adapted to be located on or near said item, said paging device having a unique paging device identification code and including:
 - (1) an RF receiver for receiving and detecting RF transmissions from a commercial paging service, said RF transmissions including a paging device identification code for a particular paging device and a paging message associated therewith;
 - (2) a comparator, connected to said RF receiver, for determining when the paging device identification code received from the commercial paging service equals the paging device identification code for the respective paging device;
 - (3) a decoder, connected to the RF receiver and the comparator, for decoding the paging message when enabled by said comparator, one of said paging messages including a command to emit a locator signal;
 - (b) a locator transmitter, adapted to be co-located with said item and said paging device and being connected to said paging device, said locator transmitter producing a locator signal in response to a command from said paging device; and

- (c) a locator device, within range to receive said locator signal, for determining the location of said locator transmitter;
- (d) a transponder tag, adapted to be co-located on or near said item with said paging device, said tag having means for emitting an RF signal in response to an RF interrogation, said RF signal containing a unique tag identification code;
- (e) a transponder reader for producing an RF interrogation for a transponder tag, for receiving an RF signal from a tag in response to such interrogation and for decoding the tag identification code from said RF signal; and
- (f) a computer coupled to the transponder reader and having stored therein, in association with each other, both the paging device identification code and the tag identification code.

2. (Canceled)

3. (Currently Amended) The apparatus defined in claim [[2]]1, wherein the transponder tag utilizes energy from said RF interrogation to transmit said RF signal, whereby said transponder tag requires no other power source.

4. (Previously Presented) The apparatus defined in claim 1, wherein one of said paging messages includes a command to switch off the co-located tag, and wherein said apparatus further comprises a tag control device, connected to said paging device and to said tag, for preventing said tag from responding to an RF interrogation when said switch off command is received by said paging device.

5. (Previously Presented) The apparatus defined in claim 1, further comprising a CPU, coupled to said transponder reader, for initiating a page by said commercial paging system.
6. (Original) The apparatus defined in claim 1, wherein said locator transmitter produces, and said locator device receives, a RF locator signal.
7. (Original) The apparatus defined in claim 1, wherein said locator transmitter produces, and said locator device receives, an infrared locator signal.
8. (Original) The apparatus defined in claim 6, wherein said locator transmitter produces, and said locator device receives, an ultrasound locator signal.
9. (New) A system for locating a tagged item, comprising:
 - a paging device attached or in close proximity to an item to be located, said paging device identified by a paging device address and having an RF receiver configured to receive paging signals from a paging system;
 - a transponder tag containing a unique code identifying said item, said transponder tag attached or in close proximity to said item; and
 - a transponder reader operable to receive an RF signal from said transponder tag and extract a tag identification code contained in said RF signal.

10. (New) The system of Claim 9, further comprising a server configured to receive information signals from said transponder reader and communicate information concerning the item or transponder tag to said paging system.

11. (New) The system of Claim 9, further comprising a controller configured to receive a command signal from said paging device.

12. (New) The system of Claim 11 wherein said command signal contains a command to deactivate said transponder tag.

13. (New) The system of Claim 9, further comprising a location receiver module having one or more receivers operable to determine the location of said paging device.

REMARKS/ARGUMENTS

This Amendment is submitted with a Request for Continued Examination and a petition to revive for unintentional abandonment. It is responsive to the Final Office Action mailed from the USPTO on November 17, 2003. Upon entry of the Amendment, which amends Claim 3 and adds new Claims 9-13, Claims 1-13 are pending.

In the November 17, 2003 Office Action, Claims 1 and 3-8 were rejected under 35 U.S.C. § 112, Second Paragraph, as allegedly being indefinite. Claims 1 and 4-6 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,576,692 to Tompkins et al. (hereinafter referred to as "Tompkins et al.") in view of U.S. Patent No. 5,684,859 to Chanroo et al., and further in view of U.S. Patent No. 6,236,836 to Westman et al. (hereinafter referred to as "Westman et al. Claim 3 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tompkins et al. in view of Chanroo et al. in view of Westman et al. and further in view of U.S. Patent No. 6,412,086 to Friedman et al. (hereinafter referred to as "Friedman et al."). Finally, Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tompkins et al. in view of Chanroo et al. in view of Westman et al. and further in view of U.S. Patent No. 6,424,928 to Elliott et al. (hereinafter referred to as "Elliott et al."). Applicant respectfully requests reconsideration of the claims in view of the above amendments and the comments below.

35 U.S.C. § 112, Second Paragraph, Claim Rejections

On pages 2-3 of the Office Action, Claims 1 and 3-8 were rejected under 35 U.S.C. § 112, Second Paragraph, as allegedly being indefinite. Specifically, it is asserted

in the Office Action that use of the phrase “the like” in Claims 1 and 3-8 renders the claims indefinite, and the scope of the claims unascertainable. For the following reasons Applicant believes that the § 112 rejections cannot be properly maintained.

Applicant does not disagree that use of the phrase “the like” would render the claims indefinite. However, despite what is asserted in the Office Action, that phrase is not used in any of Claims 1 and 3-8. Because the phrase is not present in the claims, the § 112 rejections cannot be properly maintained. Applicant requests, therefore, that the rejections of Claims 1 and 3-8 be withdrawn.

35 U.S.C. § 103(a) Claim Rejections

In the Office Action, independent Claim 1 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tompkins et al. in view of Chanroo et al., and further in view of Westman et al. Claims 3-8, which all depend from independent Claim 1, were also rejected as allegedly being unpatentable over Tompkins et al. in view of Chanroo et al. in view of Westman et al. and further in view of either Friedman et al. (Claim 3) or Elliott et al. (Claims 7 and 8). For the following reasons Applicant respectfully believes that these § 103(a) rejections cannot be properly maintained.

Tompkins et al. discloses a system for tracking or locating luggage in airports dispersed over a wide geographic area. The system utilizes a paging system and beeper paging units attached to each piece of luggage to be tracked or located. Each beeper paging units is assigned a unique code, so that luggage pieces can be distinguished from one another.

Chanroo et al. discloses a “selective call system” comprising a paging controller 104 coupled to a telephone network 102, a plurality of base sites 120-124, a subscriber database 130 containing location identifiers 132. A subscriber uses a selective call receiver 108, which receives call signals from the paging controller 104. A decoder/controller 306 of a selective call receiver 108 assigned to a particular subscriber compares a location identifier 132 sent from a base site of a given service area to the subscriber’s home location identifier to determine whether the subscriber has roamed to a new service area. If it is determined that the subscriber has roamed to a new service area, the selective call receiver 108 transmits an acknowledgment-back signal to the base sites of the new service area. The selective call receiver 108 also sends the new location identifier to the subscriber’s home service area so that all paging information can be routed to the new service area indicated by the new location identifier.

Westman et al. discloses a system for surveillance and localization of movable objects (e.g. transport bags for valuables, larger valuables, persons/children or certain types of domestic animals (dogs, cats, etc.)). The system uses a paging system and a “transponder” that “contains a receiver, preferably of the type in a paging system, a decoder, a logic unit, a transmitter portion and a power supply.” (Westman et al., col. 3, lines 15-19). The paging system (identified as system “A” in the specification) sends control information to the transponder (identified as system “B”).

Independent Claim 1 of the present patent application, by contrast, claims an apparatus for determining the location of an item that includes “paging device” and a “transponder tag, which is “adapted to be co-located on or near said item with said paging

device.” The “paging device is further recited to include “an RF receiver”, a “comparator” and a “decoder”.

Tompkins et al., Chanroo et al. and Westman et al., whether considered alone, in combination, or whether modified by one another, do not teach or suggest a system for locating an item having a paging device co-located with a transponder tag. Indeed, in the Office Action it is acknowledged that neither Tompkins et al. nor Chanroo et al. teach or suggest a system utilizing co-located transponder and paging device. The Westman et al. reference does not either.

It is true that the transponder in Westman et al. system contains a receiver, “preferably of the type in a paging system” (col. 3, line 17-18); however that receiver is part of the transponder. In other words, contrary to what is asserted in the Office Action, Westman et al. do not teach or suggest a system having a paging receiver that is separate and distinct from a transponder tag. For at least this first reason, Applicant respectfully believes that the § 103 rejections of Claims 1 and 4-6 cannot be properly maintained.

Further, none of the three cited references, whether considered alone, in combination, or modified by one another teach or suggest that the transponder may be a “transponder *tag*” or that the system include a “transponder reader” for “producing an RF interrogation for [the] transponder tag...and for decoding [a] tag identification code” as Claim 1 recites. At most, the three cited references only discuss a paging device address code.

Finally, none of the three cited references, whether considered alone, in combination, or modified by one another teach or suggest a system having a “computer” coupled to a “transponder reader” and having stored therein, in association with each

other, “both” a “paging device identification code” and a “tag identification code.”

Indeed, there is no teaching or suggestion whatsoever in the references of a system having a computer that stores both a paging device identification code and a tag identification code.

For at least the foregoing reasons Applicant believes that the § 103 rejection of independent Claim 1 cannot be properly maintained. Applicant respectfully requests, therefore, that the rejections of independent Claim 1 be withdrawn.

The other rejected claims (i.e. Claims 3-8) all depend from independent Claim 1. Accordingly, they are believed to be patentable over the cited art of record for at least the same reasons provided above. Applicant respectfully requests, therefore, that the § 103 rejections of dependent Claims 3-8 also be withdrawn.

New Claims

New Claims 9-13 are believed to be allowable over the cited prior art of record for at least the same or similar reasons as provided above.

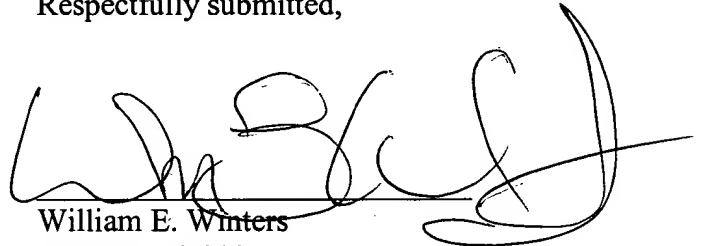
CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-282-1857.

Respectfully submitted,

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